

### **REMARKS/ARGUMENTS**

In the Office Action mailed July 15, 2009 (hereinafter, "Office Action"), claims 1-24 stand rejected under 35 U.S.C. § 103. Claims 1, 9 and 17 have been amended. Claims 25-34 have been added.

Applicant respectfully responds to the Office Action.

#### **I. Claims 1-3, 9-11 and 17-19 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-3, 9-11 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,213,060 to Kemp et al. (hereinafter, "Kemp") in view of U.S. Patent No. 6,032,162 to Burke (hereinafter, "Burke"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at \*\*37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in the claims.

Claim 1 as amended recites "creating a print job, wherein the print job is to be sent to the peripheral device; determining a network address of the peripheral device by the client device in response to the creation of the print job." Support for this amendment may be found in Applicant's

Specification on at least page 1, line 22 – page 2, line 18. Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter.

Kemp states:

The present invention concerns creation of printer instances in a printers folder on a workstation. More particularly, the present invention concerns creating a printer instance in the printers folder of a workstation for peer-to-peer communication over a local network between the workstation and the printer by accessing a website listing of printers that can be added to the printers folder of the workstation and selecting a printer from the website listing, whereby in response to the selection, identification information of the selected printer and command information is transmitted via the Internet to the workstation such that printer configuration information and print driver information of the printer are automatically obtained and installed on the workstation and the instance of the printer is created in the printers folder.

Kemp, col. 1, lines 10-24.

Kemp describes how “printer configuration information and print driver information of the printer are automatically obtained and installed on the workstation and the instance of the printer is created in the printers folder.” (Kemp, col. 1, lines 21-24). A printer instance is created “in the printers folder of a workstation for peer-to-peer communication over a local network between the workstation and the printer by accessing a website listing of printers that can be added to the printers folder of the workstation.” (Kemp, col. 1, lines 13-16). Kemp further states that “when a new printer is installed on the network, the network administrator generally adds the printer to a listing of printers maintained on a web-server.” (Kemp, col. 6, lines 41-43).

Kemp thus describes a “network administrator” adding the printer to a “listing of printers maintained on a web-server.” Prior to the “network administrator” adding the printer to the “listing of printers maintained on a web-server,” the “printer configuration information and print driver information of the printer” are not located on the “website listing of printers.” In Kemp, the workstation downloads the “printer configuration information and print driver information.” However, the workstation of Kemp cannot download the “printer configuration information and print

driver information” prior to the network administrator adding “the printer to a listing of printers maintained on a web-server” because the information has not yet been added to the web-server.

Although Kemp describes “creating documents and images,” (Kemp, col. 5, line 39), the documents and images in Kemp are not created prior to network administrator adding “the printer to a listing of printers maintained on a web-server.” In fact, “creating documents and images” prior to a network administrator adding “the printer to a listing of printers maintained on a web-server” implies that the creator of the “documents and images” would have to wait for the network administrator to “add the printer to a listing of printers maintained on a web-server” after creating the “documents and images.” Such an application is contrary to the direction of Kemp to provide “an easier way to install a printer in a printers folder on a workstation for peer-to-peer communication.” (Kemp, col. 1, lines 59-61). Thus, Kemp does not teach or suggest “creating a print job, wherein the print job is to be sent to the peripheral device; determining a network address of the peripheral device by the client device in response to the creation of the print job.”

The addition of Burke does not overcome the deficiencies of Kemp. Burke is related to the “field of digital signal processing, and in particular to the processing, storage and activation of Internet address links.” (Burke, col. 1, lines 5-7). Burke does not teach or suggest steps “in response to the creation of a print job” nor does Burke teach or suggest anything to do with print jobs. Thus, Burke does not teach or suggest “determining the network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device.”

Claim 1 as amended also recites “identifying by the client device one or more portions of the retrieved first data file as potential network addresses.” Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter.

As discussed above, Kemp states that “when a new printer is installed on the network, the network administrator generally adds the printer to a listing of printers maintained on a web-server.” (Kemp, col. 6, lines 41-43). Adding “the printer to a listing of printers maintained on a web-server” is performed by the network administrator and not by the workstation. Furthermore, adding “the printer to a listing of printers maintained on a web server” without network addresses is contrary to

the direction of Kemp to provide “an easier way to install a printer in a printers folder on a workstation for peer-to-peer communication” because the workstation would still have to identify the network addresses for the printer. In fact, the “listing of printers maintained on a web-server” of Figure 6 does show identified network addresses.

Although the “Currently available Printer(s) list” shown in Figure 6 of Kemp does show network addresses as part of the “listing of printers maintained on a web-server,” these network addresses are not identified “by the client device... as potential network addresses.” Instead, these network addresses have already been identified as network addresses by “the enterprise that maintains a listing of printers.” (Kemp, col. 6, lines 63-64). Thus, Kemp does not teach or suggest “identifying by the client device one or more portions of the retrieved first data file as potential network addresses.”

The addition of Burke does not overcome the deficiencies of Kemp. As discussed above, Burke is related to the “field of digital signal processing and in particular to the processing, storage and activation of Internet address links.” (Burke, col. 1, lines 5-7). The Office Action has not cited, not can Applicant find, any portion of Burke teaching or suggesting “identifying by the client device one or more portions of the retrieved first data file as potential network addresses.”

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from the cited references. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Kemp, alone or in combination with Burke, does not teach or suggest all of the subject matter of claim 1.

Claims 2 and 3 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 3 be withdrawn.

Claim 9 is being amended to recite “create a print job, wherein the print job is to be sent to the peripheral device; determine a network address of the peripheral device by the client device in response to the creation of the print job.” As discussed above, Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 9 is allowable. Claims 10 and 11 depend either directly or indirectly from claim

9, and are therefore allowable for at least the same reasons.

Claim 17 is being amended to recite “means for creating a print job, wherein the print job is to be sent to the peripheral device; means for determining a network address of the peripheral device by the client device in response to the creation of the print job.” As discussed above, Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 17 is allowable. Claims 18 and 19 depend either directly or indirectly from claim 17, and are therefore allowable for at least the same reasons.

## **II. Claims 4-8, 12-16 and 18-24 Rejected Under 35 U.S.C. § 103(a)**

Claims 4-8, 12-16 and 18-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp in view of Burke in further view of U.S. Patent Application Publication No. 2002/0059489 to Davis et al. (hereinafter, “Davis”). This rejection is respectfully traversed.

The standard to establish a *prima facie* case of obviousness is provided above.

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claims 4-8 depend either directly or indirectly from claim 1. Claims 12-16 depend either directly or indirectly from claim 9. Claims 18-24 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 4-8, 12-16 and 18-24 be withdrawn for the reasons above.

### **III. Conclusion**

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

/Wesley L. Austin/

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Wesley L. Austin  
Reg. No. 42,273  
Attorney for Applicant

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AUSTIN RAPP & HARDMAN  
170 South Main Street, Suite 735  
Salt Lake City, Utah 84101  
Telephone: (801) 537-1700